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EXAMINER

DENNISON, JERRY B

ART UNIT

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2143

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,415

Applicant(s)

KENMOCHI, AKIHISA

Examiner

J. Bret Dennison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in response to Amendment for Application Number 09/717,415 received on 19 September 2005.
2. Claims 1-16 are presented for examination.

Claim Rejections - 35 USC § 102

The following are quotations of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 rejected under 35 U.S.C. 102(e) as being anticipated by Lutterschmidt (U.S. Patent Number 6,356,947).

3. Regarding claim 1, Lutterschmidt disclosed a network contents managing system on a network including a personal computer, portable terminals, storage apparatuses, set top boxes, and the like, the system comprising:

a contents database retaining information about content files which are distributed to and stored in different apparatuses connected to the network (Lutterschmidt, col. 5, lines 20-30, Lutterschmidt disclosed a storage unit SDC formed by a database, lines 49-

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53, Lutterschmidt disclosed the SDC keeping track of the content stored in devices on the network);

a retrieval request detection unit for detecting a retrieval request to the contents database and outputting a retrieval request information (Lutterschmidt, col. 5, lines 45-50, Lutterschmidt disclosed the control unit SH that receives client requests for data);

a network monitoring unit for monitoring a change in an apparatus connection state to the network and, upon occurrence of a change in the connection state, outputting a new apparatus connection state as a connection state information (Lutterschmidt, col. 5, lines 1-4);

a contents monitoring unit for outputting contents modification information when the content file stored in any of the apparatuses connected to the network is modified (Lutterschmidt, col. 6, lines 10-30, Lutterschmidt disclosed the control unit SH managing the distribution of the content in the data server nodes);

a database retrieval unit for retrieving from the contents database the retained information upon receipt of the retrieval request information and outputting a retrieval result information (Lutterschmidt, col. 5, lines 45-55, Lutterschmidt disclosed retrieving contents information from the SDC upon receipt of the client request); and

a database managing unit for performing registration and modification to the contents database, the contents database retaining accessibility information for each content file, the accessibility information for each content file being updated upon receipt of the connection state information and the contents modification information (Lutterschmidt, col. 4, lines 35-57, col. 5, lines 1-5, 35-45, col. 6, lines 10-26,

Lutterschmidt disclosed managing status data and content data in the SDC database where the assignment of a data server node is based on if the server node includes the contents data as well as the current status of the data server node); and

a retrieval result output unit for outputting the retrieval result information received from the database retrieval unit, to the apparatus which has made the retrieval request thereby reporting the accessibility of content (Lutterschmidt, col. 7, lines 25-35, Lutterschmidt disclosed the control unit SH informing the client of the assignment of the data server node).

Claims 1, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sims et al. (U.S. Patent Number 5,434,775).

4. Regarding claim 1, Sims discloses a network contents managing system on a network including a personal computer, portable terminals, storage apparatuses, set top boxes, and the like, the system comprising:

a contents database retaining information about content files which is distributed to and stored in different apparatuses connected to the network (Sims s, col. 13, lines 4-20, 40-50, Sims discloses a database management computer that maintains a database of information distributed to users for reports);

a retrieval request detection unit for detecting a retrieval request to the contents database and outputting a retrieval request information (Sims s, col. 13, lines 40-50, Sims discloses an activity database that generates reports for users);

a network monitoring unit for monitoring a change in an apparatus connection state to the network and, upon occurrence of a change in the connection state, outputting a new apparatus connection state as a connection state information (Sims s, col. 7, lines 40-50, Sims teaches continuously monitoring devices);

a contents monitoring unit for outputting contents modification information when the content file stored in any of the apparatuses connected to the network is modified (Sims s, col. 7, lines 40-50, Sims teaches continuously monitoring devices, col. 13, lines 4-20, Sims discloses keeping the database up to date with modified device information, col. 14, lines 35-40, Sims teaches generating reports of the devices);

a database retrieval unit for retrieving the contents database upon receipt of the retrieval request information and outputting a retrieval result information (Sims s, col. 13, lines 40-50, Sims discloses an activity database that generates reports for users); and

a database managing unit for performing registration and modification to the contents database, the contents database retaining accessibility information for each content file, the accessibility information for each content file being updated upon receipt of the connection state information and the contents modification information (Sims s, col. 13, lines 4-20, Sims discloses an activity database that generates reports for users); and

a retrieval result output unit for outputting the retrieval result information received from the database retrieval unit, to the apparatus which has made the retrieval request

thereby reporting the accessibility of content (Sims s, col. 13, lines 40-50, Sims discloses an activity database that generates reports for users).

5. Regarding claim 14, Sims discloses the limitation, substantially as claimed, as described in claim 1, including wherein:

the contents database associates the content file with an apparatus identification number, and retains the apparatus identification number while including apparatus usable state data with the apparatus identification number (Sims s, col. 5, lines 55-65, col. 13, lines 4-12), and

the database managing unit performs registration and modification to the contents database upon receipt of the connection state information and the contents modification information (Sims col. 13, lines 12-20).

6. Regarding claim 15, Sims discloses the limitation, substantially as claimed, as described in claim 14, including wherein:

the database managing unit changes the apparatus usable state data not shown in the connection state to be unusable (Sims s, col. 7, lines 40-46, col. 13, lines 10-20, Sims discloses a condition code which is maintained).

7. Regarding claim 16, Sims discloses the limitation, substantially as claimed, as described in claim 14, including wherein the database managing unit changes the apparatus usable state data of the information including the apparatus identification

number shown in the connection state to be usable (Sims s, col. 7, lines 40-46, col. 13, lines 10-20, Sims discloses a condition code which is maintained).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Patent Number 6,415,289) in view of Hasegawa et al. (U.S. Patent Number 6,370,587).

8. Regarding claim 1, Williams disclosed a network contents managing system on a network including a personal computer, portable terminals, storage apparatuses, set top boxes, and the like, the system comprising:

a contents database retaining information which is distributed to and stored in different apparatuses connected to the network (Williams, col. 6, lines 10-15, Williams teaches a database server storing information about contents stored on storage devices);

a retrieval request detection unit for detecting a retrieval request to the contents database and outputting a retrieval request information (Williams, col. 6, lines 37-50, and **Fig. 11**, Williams teaches an API 1130 detecting a retrieval request from the client);

a contents monitoring unit for outputting contents modification information when the information stored in any of the apparatuses connected to the network is modified (Williams, col. 6, lines 20-30, and lines 35-40, Williams teaches the database server maintaining a database of identifying information concerning other information stored on the network, so when a client requests index information, it will be up to date);

a database retrieval unit for retrieving the contents database upon receipt of the retrieval request information and outputting a retrieval result information (Williams, col. 6, lines 55-60, Williams teaches the database server returning the requested information); and

a retrieval result output unit for outputting the retrieval result information received from the database retrieval unit, to the apparatus which has made the retrieval request (Williams, col. 7, lines 20-35, Williams teaches the database server issuing a command to deliver the requested information).

a database managing unit for performing registration and modification to the contents database upon receipt of the connection state information and the contents modification information (col. 6, lines 10-15).

Williams also disclosed a network server being a general purpose computing device which processes and routes network commands to their intended devices (col. 5, lines 64-67), and that there is a large number of both clients and servers connected to the network and each device is conventionally assigned a unique identifier or an address (col. 6, lines 15-20), which means that the devices are monitored for connection to the network.

However, Williams did not explicitly state having a network monitoring unit for monitoring a change in an apparatus connection state to the network and, upon occurrence of a change in the connection state, outputting a new apparatus connection state as a connection state information;

In an analogous art of networking, Hasegawa discloses network connection devices being monitored for connection states, and informing other network devices of the updating of the connection states (col. 14, lines 50-67).

Williams disclosed maintaining a database of identifying information which identifies the requested content that is stored throughout the network (Williams, col. 6, lines 20-36) as well as keeping the identifying information up to date (Williams, col. 7, lines 20-35). It would have been obvious to one of ordinary skill in the art at the time of the invention that in order to keep the content up to date, the devices that the content is stored on must be working properly, which means that the accessibility of the content is based on the device status.

Since Hasegawa provides the monitoring of network devices for their connection states, it would have been obvious to one in the ordinary skill in the art at the time the invention was made to combine the teachings of Williams and the teachings of Hasegawa to improve the storage management system of Williams by monitoring the storage devices of the network for connections (Hasegawa, col. 1, line 65 through col.2, line 1) in order to stay updated with additions and deletions to the network (Williams, col. 7, lines 25-33), as well as to provide a more efficient database of identifying information of the content by monitoring the state information of each device

9. Regarding claim 2, Williams and Hasegawa teach all of the limitations substantially as claimed, as described in claim 1, including wherein the contents monitoring unit further outputs the contents modification when the information is modified by mounting/removing a removable medium (Williams, col. 6, lines 10-43, Williams teaches the database server maintaining a database having information about the information stored on the storage devices, and outputting an index of this information at a clients request).

Claims 3-4 rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Hasegawa as applied to claims 1-2 above, and further in view of Takahashi et al. (U.S. Publication Number 2002/0035620 A1).

10. Regarding claims 3 and 4, Williams and Hasegawa teach all of the limitations substantially as claimed, as described in claims 1 and 2. Hasegawa also teaches an update notification section monitoring connections of devices (Hasegawa, col. 14, lines 50-67).

However Williams and Hasegawa do not explicitly state wherein the network monitoring unit detects a power on/off of the apparatuses connected to the network and retains in the contents database an information of the power on/off of the apparatuses connected to the network as well.

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In an analogous art to networking, Takahashi discloses a system of controlling network devices including detection of power on/off of the connected devices (pages 22-23, paragraphs 312 -316).

Therefore it would have been obvious to one in the ordinary skill in the art at the time the invention was made to combine Williams and Hasegawa with Takahashi to provide control over power management of multimedia devices, supplying electrical power to a required multimedia device at only a required time, so that power consumption can be suppressed (Takahashi, page 23, paragraph 0323).

11. Regarding claims 5-8, Williams, Hasegawa, and Takahashi disclosed the limitations substantially as claimed, as described in claims 1-4, including the system further comprising a power monitoring unit for monitoring a power operation of an apparatus connected to the network and a remote start unit for activating at least one of the contents database, the retrieval request detection unit, the network monitoring unit, the database retrieval unit, the database managing unit, and the retrieval result output unit at another apparatus connected to the network (Takahashi, page 23, paragraphs 0318-0323, Takahashi teaches the system determining Power on/off and updating the database). See 5 for motivation.

12. Regarding claims 9-12, Williams, Hasegawa, and Takahashi teach all of the limitations substantially as claimed, as described in claims 5-8, including comprising a

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power operation unit for operating a power of another apparatus connected to the network (Takahashi, page 23, paragraphs 0318-0323).

13. Regarding claim 13, Examiner takes Official Notice (see MPEP § 2144.03) that "database administration" in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight. See *Sims* (U.S. Patent Number 5,434,775), col. 7, lines 60-67.

Response to Amendment

Applicant's arguments and amendments filed on 19 September 2005 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., *by incorporating new limitations into the independent claims, which will require further search and consideration*) to the claims which significantly affected the scope thereof.

Applicant states that Examiner does not specify any section in the cited references that discloses or suggests the following features of claim 1 of the present invention: "reporting the accessibility of the content" [see Applicant's response, page 10].

Claim 1 recites, "thereby reporting the accessibility of content" at the end of the claim. Any language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEP 2106, section II, subsection C for specific examples.

This limitation does not further limit the claim due to the fact that all it does is show an outcome, which as shown by the above section of the MPEP, is not a required step to be performed, and therefore does not limit the scope of the claim.

However, Williams did disclose "reporting the accessibility of the content" by responding to the client's request by returning a listing of movies stores on the

network. The client then selects a particular movie and then connects to the storage device that contains the movie and the movie is delivered to the client (Williams, col. 8, lines 1-5).

Applicant argues that "Williams does not disclose or suggest retaining accessibility information for each content file, the accessibility information for each content file being updated upon receipt of the connection state information" [see Applicant Response, page 13, paragraph 3].

As shown in the above mappings, (also acknowledged by Applicant on page 13, paragraph 2), Williams disclosed the server maintaining identifying information about the information stored on the network including name, location, data type, access rights, accesses, originator, and other information, and that the index information maintained by the server may include the information location, type, source, rating, and the date and time the information was stored (Williams, col. 6, lines 20-36). One of ordinary skill in the art would interpret accessibility information to include a file's location, data type, access rights, access, and the originator. As shown in the cited mapping, Williams disclosed that the server includes "other information" regarding the identifying information. Although not required by claim 1, it would have been obvious to one of ordinary skill in the art that this identifying information, along with the content, is provided by devices that are powered on and working properly. Otherwise, there would be no reason to provide such data to the requesting clients. In other words, if the devices were shut off, detached from the network, or not working properly, the server

would not provide the content to the client. Therefore it would have been obvious for one of ordinary skill in the art to interpret such identifying information for content to the content availability.

As shown in the above mappings, Williams also disclosed information updates in the database (Williams, col. 7, lines 20-35).

Applicant argues that Hasegawa does not cure the deficiencies of Williams, but does not provide any explanation other than citing the abstract of Hasegawa.

Applicant states that "Sims does not mention reporting the accessibility of the content" and "Sims does not disclose or suggest retaining accessibility information for each content file" [See Applicant's Response, pages 11-12].

Sims disclosed an activity database and an inventory database, both being highly dynamic in that their contents change often based on the devices that store the content, as well as generating reports on the inventory (Sims, col. 13, lines 4-20, 40-50).

Regarding the Official Notice, Applicant argues that it "does not cure the deficiencies of the cited references as they relate to independent claim 1." As cited by Examiner in the Official Notice, Sims clearly showed that "database administration" in a computer networking environment was well known in the art at the time the invention was made, as showed in Sims (U.S. Patent Number 5,434,775), col. 7, lines 60-67.

As it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as

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broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

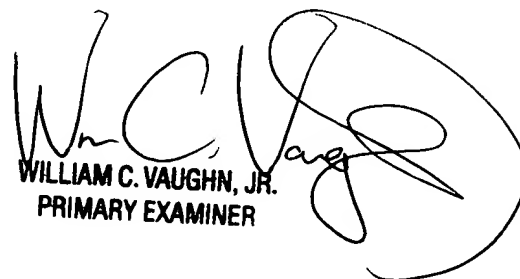
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. B. D.
Patent Examiner
Art Unit 2143



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PRIMARY EXAMINER